

**Remarks**

Claims 1-3 and 5-38 remain in the Application. Claims 1, 5, 18, and 21 have been amended. New claims 29-38 have been added to the Application. Allowance of the remaining claims is respectfully requested.

Claims 1, 5, 18 and 21 have each been amended to replace the term "advanced routing services provider" with "hosted advanced routing server." This amendment attempts to use claim language that is more consistent with the specification, and was not made in view of the documents cited in the Office Action.

Claims 1-2, 5-6, 16, 18, 20-21, 25 and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Number 6,618,377 B1 (Miriya).

Reconsideration and removal of this rejection are respectfully requested.

Claims 1-2, 16, 18, 20-21, 25 and 27 each recite a feature, either directly or indirectly, of receiving a packet at one node and sending it to another node to perform advance routing services or advanced network services. At least this feature is not disclosed by any of the cited documents, including Miriya.

Miriya describes a technique to backup ATM network devices using an ATM Address Resolution Protocol (ATMARP). As described in Miriya, a first ATM device may send a request to an ATMARP server requesting an ATM address for a second ATM device using an IP address for the second ATM device. The ATMARP server may lookup the ATM address for the second ATM device using the IP address, and sends the IP address to the first ATM device. The first ATM device may then send a data packet to the second ATM device using the received ATM address. Miriya, Col. 3: Lines 48-65.

Miriyala fails to anticipate claims 1-2, 16, 18, 20-21, 25 and 27. For example, the first ATM device sends a request for the ATM address for the second ATM device to the ATMARP server. The first ATM device then sends data packets to the second ATM device. By way of contrast, the claimed subject matter receives a packet at one node and sends it to another node to perform advance routing services or advanced network services. The node performing the advance routing services or advanced network services may send the packet to its next hop. Miriyala therefore fails to anticipate claims 1-2, 16, 18, 20-21, 25 and 27 since the ATMARP server does not send or receive the packet to be routed. Removal of the rejections for claims 1-2, 16, 18, 20-21, 25 and 27 is respectfully requested.

Claims 5 and 21 have been amended to further define "advanced routing services" as "dynamic routing." Claim 6 depends from claim 5. Miriyala does not disclose dynamic routing. Rather, the ATMARP server implements static routing by translating an IP address to an ATM address. Removal of the rejections for claims 5, 6 and 21 is respectfully requested.

Claims 3, 7, 17, 19, 22, 26 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Miriyala in view of USPN 6,493,349 B1 (Casey). Claims 8-9, 11-13, 15 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Miriyala in view of USPN 6,343,326 B2 (Acharya). Claims 10, 14 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Miriyala in view of Acharya and further in view of Casey. Applicant respectfully traverses these rejections.

Claims 3, 7, 8-9, 10-15, 17, 19, 22-24, 26 and 28 represent patentable subject matter over Miriyala, Casey and Acharya, whether taken alone or in combination.

Removal of these rejections is respectfully requested.

Claims 3, 8-11, 17, 19 and 26 each recite the feature, either directly or indirectly, of receiving a packet at one node and sending it to another node to perform advance routing services or advanced network services. At least this feature is not disclosed by any of the cited documents, including Miriyala, Casey and Acharya. Therefore, the combination of these cited documents would not disclose the claimed subject matter. Removal of the rejections for claims 3, 8-11, 17, 19 and 26 is respectfully requested.

Claims 7, 22 and 28 each recite the feature, either directly or indirectly, of dynamic routing. At least this feature is not disclosed by any of the cited documents, including Miriyala, Casey and Acharya. Therefore, the combination of these cited documents would not disclose the claimed subject matter. Removal of the rejections for claims 7, 22 and 28 is respectfully requested.

With respect to claims 12-15 and 23-24, the Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP 706.02(j).

None of the cited documents provide the first criteria of showing a suggestion or motivation to combine the references to arrive at the subject matter of claims 12-15 and 23-24. Miriyala fails to discuss, in any context, packet classification. Therefore, Miriyala does not provide the requisite first criteria. Acharya is directed to converting an IP flow to an ATM flow, while Casey is directed to VPN networks. Both Acharya and Casey fail to discuss routing a packet from one node to another node to provide advanced routing services or advanced network services. Therefore, Acharya and Casey also fail to provide the requisite first criteria.

Further, none of the cited documents meet the second criteria of having a reasonable expectation of success. Miriyala, Acharya and Casey are all generally directed to ATM systems, but each discloses completely different techniques to use the ATM system. For example, Miriyala is directed to converting an IP address to an ATM address. Acharya is directed to converting an entire IP flow to an ATM flow. Casey is directed to a VPN network over an ATM network. These concepts are widely disparate, and therefore there is no reasonable expectation that the techniques of each may be combined in a successful manner.

For at least the above reasons, the Office Action fails to present sufficient evidence to meet its burden of a prima facie case of obviousness. Accordingly, removal of this rejection for claims 12-15 and 23-24 is respectfully requested.

It is believed that claims 1-3 and 5-38 are in allowable form. Accordingly, a Notice of Allowance to this effect is earnestly solicited.

Appl. No. 09/823,459

Amendment Dated 1/7/2004

Reply to Office Action of October 7, 2003 (Paper No. 7)

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: 1/7/04.

Anne Collette

1/7/04

Date

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